

REMARKS

Claims 1-6, 8-17 and 19-22 are before the examiner.

Claims 1, 6, 16 and 22 have been amended to address the objections as recommended by the examiner.

Applicant thanks the examiner for indicating claims 17 and 19-22 are allowed over the prior art.

Claims 1-6 and 8-16 were rejected as obvious over Labyer (US 4033701) in view of Percival-Smith (US 5468106) and/or Kennedy (US 5904071).

The obviousness rejection of the claims appears to be premised on an interpretation of the claims by which certain features in claims 1, 2, 5, 9 and 10 are considered optional or conditional, viz., “adapted to grip the power end component,” “adapted to grip the fluid end component,” “when arranged on the rod axis,” and “adapted to receive a nut or lock.”

The alleged optionality or conditionality of these terms is respectfully traversed. MPEP 2111.04 indicates that “adapted to,” “wherein” and “whereby” clauses may or may not be a limitation in a claim, and an appropriate determination depends on the specific facts of the case. The Office action cites no facts of the case or any reason whatsoever why the language is not considered a limitation on the claim. When as here the clause states a condition that is material to patentability, it cannot be ignored to change the substance of the invention. *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005). Nevertheless, applicant has amended claims 1, 2, 5, 9 and 10 to clarify that the clauses are neither optional nor conditional.

The Office action asserts that Labyer teaches all of the limitations of claim 1, except wherein the tensioning device comprises a piston to provide a load in said tensioning device solely orthogonal to said rod axis and thereby secure said components against release, and cites Percival-Smith for the use of a tensioning device. However, the Office action appears to overlook the limitation in claim 1 that the piston rod assembly as claimed comprises “one or more clamping members . . . located between the power end and the fluid end.” For avoidance of doubt, applicant has amended claim 1 to affirmatively recite that the phrase “between the power end and the fluid end” relates to the position of the clamping members.

In contrast, Labyer discloses a pair of clamping members that hold the power end and fluid end with flat transverse end surfaces 26, 42 that are in planar abutment:

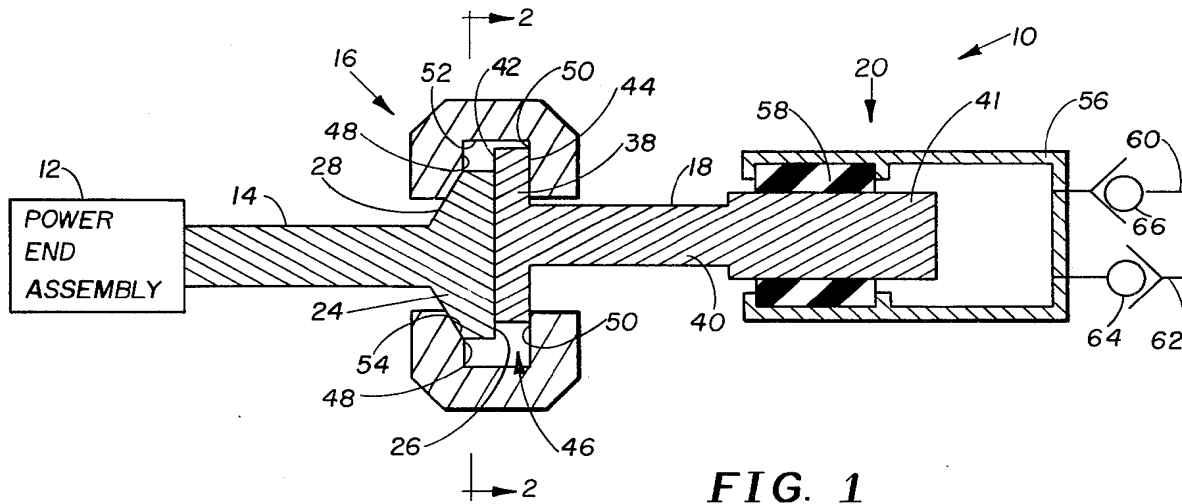


FIG. 1

The surfaces 26, 42 are flat to allow relative sliding or offset during the connection in order for the “self-aligning” functionality of the Labyer clamp to work according to the inventive intent. See column 1, lines 33-38 and column 2, lines 1-4; column 2, lines 34-36 and 58-60. Labyer teaches squarely away from locating the clamping member between the abutting planar surfaces of the power and fluid ends.

Respectfully, the alleged combination of Labyer and Percival-Smith fails to obtain the invention claimed. Kennedy is cited solely for the use of a spring and likewise does not overcome the deficiencies of Labyer and Percival-Smith. A prima facie obviousness rejection has not established. Withdrawal of the rejection and allowance of all claims are respectfully requested.

Entry of the amendments to the claims is respectfully requested after the final Office action because they raise no new issues and either place the case in condition for allowance or better form for appeal.

The claims, as amended, are now in condition for allowance. Applicant respectfully solicits a prompt notice of allowability. In the alternative, applicant invites the Office to telephone the undersigned attorney if there are any other issues outstanding which have not been presented to the Office's satisfaction.

The Office is authorized to charge deposit account 501285 for any fees due in connection with this communication, or to refund any overpayment.

Respectfully submitted,

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Date

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